

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Yoram SELA

Confirmation No.: 3015

Application No.: 10/500,634

§371 Date: January 24, 2005

Art Unit: 1618

I.A. No.: PCT/IL02/00890

I.A. Filing Date: November 7, 2002

Examiner: Jake Minh Vu

For: EXTENDED RELEASE COMPOSITIONS COMPRISING AS ACTIVE
COMPOUND VENLAFAXINE HYDROCHLORIDE

Atty.'s Docket: SELA=5

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building, Mail Stop Amendment
401 Dulany Street
Alexandria, VA 22314

Date: November 12, 2009

Sir:

Transmitted herewith is a ☒ REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

☐ Small Entity Status: Applicant claims small entity status. See 37 CFR §1.27.

☒ No additional fee is required.

☐ The fee has been calculated as shown below:

| (Col. 1) | (Col. 2) | (Col. 3) |
|---|---------------------------------------|----------------------------|
| CLAIMS REMAINING AFTER AMENDMENT | HIGHEST NO. PREVIOUSLY PAID FOR | PRESENT EXTRA EQUALS |
| TOTAL | MINUS ** 20 | |
| INDEP. | MINUS *** 3 | |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | |

| SMALL ENTITY | |
|----------------------|-------------------|
| RATE | ADDITIONAL FEE |
| x 26 | \$ |
| x 110 | \$ |
| + 195 | \$ |
| ADDITIONAL FEE TOTAL | |

| OTHER THAN SMALL ENTITY | |
|-------------------------|-------------------|
| RATE | ADDITIONAL FEE |
| x 52 | \$ |
| x 220 | \$ |
| + 390 | \$ |
| TOTAL | |

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity Response Filed Within

☐ First - \$ 65.00
☐ Second - \$ 245.00
☐ Third - \$ 555.00
☐ Fourth - \$ 885.00

Month After Time Period Set

Other Than Small Entity Response Filed Within

☐ First - \$ 130.00
☐ Second - \$ 490.00
☐ Third - \$ 1110.00
☐ Fourth - \$ 1730.00

Month After Time Period Set

[] Less fees (\$ _____) already paid for _____ month(s) extension of time on _____.

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

☐ Payment in the amount of \$ _____ will be made using the on-line filing system.

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant

By 
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: SELA=5

| | | |
|------------------------------|---|------------------------|
| In re Application of: |) | Confirmation No.: 3015 |
| |) | |
| Yoram SELA |) | Examiner: Jake Minh Vu |
| |) | |
| Appln. No.: 10/500,634 |) | Group Art Unit: 1618 |
| I.A. Appln.: PCT/IL02/00890 |) | |
| |) | Washington, D.C. |
| \$371 Date: January 24, 2005 |) | |
| I.A. Filed: November 7, 2002 |) | November 12, 2009 |

For: EXTENDED RELEASE COMPOSITIONS COMPRISING
AS ACTIVE COMPOUND VENLAFAXINE HYDROCHLORIDE

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REPLY TO RESTRICTION REQUIREMENT

Sir:

The Applicant is in receipt of the Office Action mailed October 14, 2009, entirely in the nature of a restriction requirement.

Applicant has been required to elect one from among the three groups set forth at the top of page two the Office Action of the October 14, 2009. As Applicant is required to make an election even when the requirement is traversed, Applicant hereby respectfully and provisionally elects Group I, presently claims 29-43, with traverse and without prejudice.

The requirement is traversed on the basis that the wrong criteria have been used in making the requirement. The present application is the U.S. national phase of International Application No. PCT/IL02/00890, so the proper criteria for any restriction requirement would be the unity of invention criteria under the Patent Cooperation Treaty (PCT) Rules 13.1 and 13.2. Please see MPEP 823 and 1896, as well as 37 CFR §§1.475 and 1.499. Thus, the PCT prohibits the present restriction requirement.

A review of claims 44 and 45 (Groups II and III respectively) should reveal unity of invention with the elected Group I claims. We are dealing with a single compound. Claims 44 and 45 both depend from and incorporate the subject matter of elected claim 31. It is inconceivable that claims 44 and 45 could be deemed to be directed to inventions separate in the sense of PCT Rules 13.1 and 13.2 from the elected invention of Group I. The requirement should be withdrawn and all the claims should be examined on the merits, and such is respectfully requested.

In re of Yoram SELA
Application No. 10/500,634
Response to Restriction filed November 12, 2009

If the Examiner has any questions or suggestions, he is respectfully requested to contact the undersigned at (202) 628-5197.

Applicant now respectfully awaits the results of an examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By

A handwritten signature in black ink, appearing to read 'S. Neimark', is written over a horizontal line.

Sheridan Neimark
Registration No. 20,520

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